

REMARKS

Reconsideration of this application is respectfully requested. Claims 1-5 and 11-25 are pending in the present application. Claims 1-5 and 11-25 stand rejected.

Claim Rejections – 35 U.S.C. §103

Claims 1-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Thibadeau** (USP 5,565,909, previously cited) in view of **Iggulden** (USP 6,002,443, previously cited). For the reasons set forth in detail below, this rejection is respectfully traversed.

As will be discussed in detail below, it is respectfully submitted that a *prima facie* case of obviousness has not been established and the rejection under §103 is improper because (1) the combination of references does not disclose or suggest all claimed elements, and (2) there is no motivation or incentive to combine the references.

Initially, however, applicant requests clarification of the following comment in the Examiner's ***Response to Arguments***:

In response to applicant's arguments against the references individually, one cannot show obviousness by attacking the references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). (See second paragraph of response to arguments.)

Specifically, applicant respectfully requests that the Examiner address how the patentability arguments presented in the previous response attacked the references individually in view of the fact that (1) it is well established that "To establish *prima facie* obviousness of a

claimed invention, ***all the claim limitations*** must be taught or suggested by the prior art” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (See Manual of Patent Examining Procedure (MPEP) §2143.03); and (2) in the previous response, it was argued “it is respectfully submitted that neither **Thibadeau** nor **Iggulden** nor any of the other cited references disclose or suggest “*judgment means for judging whether or not video and audio which are being currently outputted are a commercial (CM) appended to a program, said controller being so constructed as to feed to said video/audio output means the advertising information selected when said judgment means judges that they are a commercial,*” as presently recited in claims 1, 2 and 5. (See page 15, line 19 – page 16, line 3 of the previous response).

It should be clear that if **all** of the cited references fail to disclose or suggest a certain claimed element, then ***all of the claim limitations*** are not taught or suggested by the combination of references. In other words, it was properly argued that the ***combination of references*** does not disclose or suggest all the claim limitations.

Clarification of the Examiner’s position is respectfully requested.

First, as will be discussed in detail below, it is respectfully submitted that ***all the claim limitations*** recited in present independent dclaims 1, 2 and 5 are not taught or suggest by the prior art references applied against the claims, and therefore the rejection under §103 is improper.

The Examiner recognizes that **Thibadeau** does not disclose “*judgment means for judging whether or not video and audio which are being currently outputted are a commercial (CM) appended to a program, said controller being so constructed as to feed to said video/audio output means the advertising information selected [by the contrast between the information*

related to the current position and the advertising area information] when said judgment means judges that they are a commercial,” as presently recited in claims 1, 2 and 5.

The Examiner relies on the **Iggulden** reference to teach the features missing from **Thibadeau**. **Iggulden** discloses a system that identifies a commercial advertisement in a broadcast signal and either (1) mutes the video and audio portions of the commercial, (2) completely cuts off the commercial and replaces the broadcast feed with a logo, or (3) switches the reception channel upon detection of the commercial advertisement.

Thus, while it may be reasonable for the Examiner to assert that **Iggulden** discloses a “*judgment means for judging whether or not video and audio which are being currently outputted are a commercial (CM) appended to a program*”, **Iggulden** does not disclose or suggest the feature “*said controller being so constructed as to feed to said video/audio output means the advertising information selected [by the contrast between the information related to the current position and the advertising area information] when said judgment means judges that they are a commercial*”. More specifically, the logo that replaces the commercial broadcast feed in **Iggulden** is not advertising information *selected by the contrast between the information related to the current position and the advertising area information*.

Thus, it is submitted that the combination of **Thibadeau** and **Iggulden** does not disclose or suggest all claimed elements. The rejection under §103 is therefore improper and should be withdrawn for at least this reason.

Second, it is respectfully submitted that the references do not provide the requisite motivation or incentive to combine the references, as required under §103. In fact, it is submitted that there is significant disincentive for combining the references.

Specifically, the motivation for combining the references provided in the Office Action is “for the advantage of substituting undesirable advertisements to the user.” See Office Action, page 5, lines line 5. However, it is submitted that the **Thibadeau** and **Iggulden** references teach away from each other and teach away from this advantage and thus *destroy the motivation for combining the references*. It is well established that references that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994).

In particular, **Thibadeau** specifically teaches that a user enter a geographic location code into a data processor coupled to the user’s receiver to define the user’s selected locations of interest (see, e.g., Abstract). In other words, the user in **Thibadeau** is *provided with advertisements that the user desires to see and hear* based on the user’s selected locations. However, **Iggulden** teaches detecting a commercial advertisement in a broadcast and substituting something else (e.g., mutes the video and audio, changes the channel, substitutes a logo) for that commercial broadcast. In other words, **Iggulden** teaches *preventing the user from seeing the commercial advertisement*. Thus, it is submitted that the **Thibadeau** and **Iggulden** teach away from each other because the commercial advertisement that a user desires to be delivered as taught by the **Thibadeau** system would be detected and (1) the video and audio portions of the commercial muted, (2) the commercial completely cut off and replaced with a logo, or (3) the

reception channel switched upon detection of the commercial advertisement, as taught by the **Iggulden** system.

In other words, the references teach away from each other in that one reference seeks to provide a user with a desired commercial and the other seeks to prevent a user from watching commercials.

Further, it is submitted that it is well established that a §103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference is not proper and the *prima facie* case of obviousness cannot be properly made. To the contrary, there would be disincentive for combining the references. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As discussed above, the purpose or function of the **Thibadeau** reference is to provide a user with, e.g., commercial advertisements selected according to the user's geographic location. In contrast, the purpose or function of the **Iggulden** reference is to detect a commercial and prevent a user from having to watch and listen to that commercial. Thus, if the references are combined, the function of the **Thibadeau** reference is destroyed because the commercials selected by the user for viewing would be detected and replace with other information (e.g., a logo).

Accordingly, it is submitted that there is a lack of motivation to combine **Iggulden** with **Thibadeau** because the function of the **Thibadeau** reference would be destroyed as a result of the combination.

Finally, the **Thibadeau** reference is directed to a system that filters broadcast information based on the geographic location of the recipient. **Thibadeau** is *completely unrelated* to detecting when a commercial is being broadcast. **Thibadeau** is only related to distributing information, such as a commercial or a local emergency warning or other information, based on the geographic location of users.

On the other hand, **Iggulden** is directed to a system that detects a commercial in a broadcast signal, but is *completely unrelated* to distributing commercials according to geographic location of users.

It is respectfully submitted that there is no teaching, suggestion or motivation provided in the references to combine a reference that is completely unrelated to detecting when a commercial is being broadcast (**Thibadeau**) with a reference that is completely unrelated to distributing commercials according to geographic location of users (**Iggulden**) to result in the presently claimed invention. The only reference that suggests an interrelation of these features is applicant's specification. Therefore, it is submitted that the combination of references is the result of improper hindsight reconstruction of the invention based on applicant's teachings.

Accordingly, it is respectfully submitted that the rejection of claims 1-5 under §103 is improper for all of the above reasons. Reconsideration and withdrawal of the rejection under §103 are respectfully requested.

Claims 11-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Thibadeau** and **Iggulden**, as applied to claims 1-5, and further in view of **Eldering** (US Patent App. 2002/0178445, previously cited).

Claims 16-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Thibadeau and Iggulden**, as applied to claims 1-5, and further in view of **Wright** (USP 33,808, previously cited).

Claims 21-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Thibadeau and Iggulden**, as applied to claims 1-5, and further in view of **Zigmond** (USP 6,698,020, previously cited).

Each of claims 11-15, 16-20 and 21-25 depend either directly or indirectly from claims 1, 2 and 5. It is submitted that each of the dependent claims is allowable for the same reasons set forth above with respect to independent claims 1, 2 and 5 by virtue of their dependency therefrom.

CONCLUSION

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

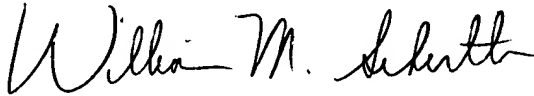
Application No. 09/988,336
Art Unit: 2623

Request for Reconsideration under 37 C.F.R. §1.116
Attorney Docket No.: 042206

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read "William M. Schertler". The signature is fluid and cursive, with the first name "William" being the most prominent.

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